

Remarks

Claims 23-42 and 44-49 were pending. By way of this response, claims 23 and 48 have been amended, claim 32 has been cancelled, and claims 50-53 have been added. Support for the amendments to the specification and the claims can be found in the application as originally filed, and no new matter has been added. Accordingly, 23-31, 33-42 and 44-53 are currently pending.

In addition, applicant acknowledges that claims 24-31, 38-42, 44, 45, and 47 are allowable.

Claim Rejections

Claims 23, 32-37, 46, 48, and 49 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Oshlack et al. (U.S. Pat. No. 5,472,712).

Claim 32 has been cancelled, and claims 23 and 48 have been amended, and claims 50-53 have been added, as set forth above. Applicant respectfully traverses the rejection as it relates to the amended and new claims. Because claims 33-37 and 46 depend from claim 23, applicant submits that the amendments to claim 23 similarly apply to claims 33-37 and 46.

Claim 23 has been amended to recite that the coating comprises a copolymer made up of units of only two different monomers. In contrast, Oshlack et al. discloses a coating that comprises only one monomer (i.e., ethylcellulose). Oshlack et al. does not disclose, teach, or even suggest a coating

comprising a copolymer made up of units of only two different monomers.

Accordingly, applicant submits that claim 23 and the claims dependent therefrom are unobvious from and patentable over Oshlack et al. under 35 U.S.C. § 103.

Claim 48 has been amended to make more clear that the claim is directed to a method of releasing an additive composition into a open circulating cooling water system of a cooling tower. Oshlack et al. does not disclose, teach, or even suggest adding a controlled release additive composition into a cooling tower. As indicated in the Office Action, Oshlack et al. discloses the use of coated tablets for swimming pools.

Applicant submits that a *prima facie* case of obviousness has not been established regarding the use of the tablets disclosed by Oshlack et al. in an open circulating cooling water system of a cooling tower, let alone the methods recited in the present claims. In particular, the Office Action fails to indicate where a motivation or suggestion in the prior art is provided to modify the teachings of Oshlack et al. to practice a method of releasing an additive composition into an open circulating cooling water system of a cooling tower. The Office Action simply states that one skilled in the art would be motivated to substitute calcium hypochlorite for the therapeutic acetaminophen to prepare a controlled release disinfecting agent. Absent such a suggestion or motivation, an obviousness rejection under 35 U.S.C. § 103 cannot be maintained.

In addition, applicant submits that one of ordinary skill in the art would not be motivated to modify the teachings of Oschlack et al. to render obvious the method recited in claims 48 and 49, as well as new claims 50-53. Cooling towers are heat exchange or transfer devices, which extract heat through the cooling of a water stream to a lower temperature. In general, cooling towers are configured to pass relatively warm water over a material or structure which is effective to provide an expanded air-water interface to facilitate cooling of the water. Swimming pools are not configured like cooling towers or in any manner that even resembles a cooling tower. Swimming pools provide an entirely different environment and perform an entirely different function compared to cooling towers. Furthermore, the coatings of the compositions are insoluble in the aqueous coolant of a cooling tower, as recited in the present claims. As indicated in the present application (e.g., page 6, lines 21-30), the temperature of a cooling tower varies, and can vary from about 70 degrees F to about 150 degrees F. Swimming pools do not exhibit such wide temperature fluctuations.

The specifications, process requirements and operating conditions of cooling towers are substantially different and distinct from those of swimming pools. Because of these differences, one of ordinary skill in the art would not even consider methods of swimming pool maintenance in developing methods to treat cooling towers. Thus, based on the disclosure of Oschlack et al., one of ordinary skill in the art would not be motivated to use the swimming pool tablets in Oschlack et al. in methods of treating cooling towers, as recited in the present claims.

Accordingly, applicant submits that claims 48 and 49, as well as claims 50-53 are unobvious from and patentable over Oschlack et al. under 35 U.S.C. § 103.

In addition, each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present compositions and methods including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

In view of the above, applicant submits that the present claims, and in particular claims 23, 33-37, 46, 48, and 49, are unobvious from and patentable over Oshlack et al. under 35 U.S.C. § 103.

#### Claim Objections

Claims 24-31 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

The base claim (i.e., claim 23) has been amended as set forth above, and as discussed herein. Because claim 23 is patentable over the prior art, applicant submits that claims 24-31 are also patentable, and the objections have been overcome.

In conclusion, applicant has shown that the present claims are unobvious from and patentable over the prior art under 35

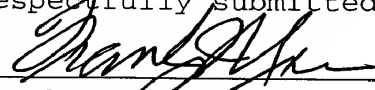
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U.S.C. § 103. Therefore, applicant submits that the present claims, that is claims 23-31, 33-42 and 44-53 are allowable, and respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: \_\_\_\_\_

9/5/03

Respectfully submitted,



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